

**REMARKS**

**I. EXAMINER INTERVIEW AND AGREEMENT**

Applicants thank the Examiner for the courtesy in conducting an interview with applicants' representative on June 2, 2005. As indicated on the Examiner's Interview Summary form, an agreement was reached regarding amendments to overcome new matter and written description issues. Upon clarification, the Examiner also agreed that the specification provides support under 35 U.S.C. § 112, first paragraph, for new SEQ ID NO. 70. The Examiner also suggested claim language for clarifying the error statement in the reissue declaration.

More particularly, the Examiner agreed that an amendment to the claim language defining X<sub>5</sub> by replacing the phrase "provided that when X<sub>1</sub> is D, X<sub>2</sub> is T, X<sub>3</sub> is S, and X<sub>4</sub> is V, then X<sub>5</sub> is not P" with the phrase "provided that when X<sub>1</sub> is D, X<sub>2</sub> is T, X<sub>3</sub> is S, and X<sub>4</sub> is V, then X<sub>5</sub> is A, R, N, D, C, Q, E, G, H, I, L, K, M, F, S, T, W, Y or V," would overcome the new matter and written description rejections directed to that language. See, e.g., amended claims 4, 15, and 32. The Examiner also agreed that applicants' specification provided written description for SEQ ID NO. 70 based on the disclosure in the specification of U.S. Patent No. 5,633,435 at SEQ ID NO:3; col. 5, ll. 50-53 (which identifies SEQ ID NO:3 as the CP4 amino acid sequence); and col. 28, ll. 54-55 (which states that the second codon of the DNA sequence encoding the CP4 amino acid sequence was converted to one for leucine). Finally, the Examiner suggested language that would be sufficient for defining the error in the reissue declaration, which has been incorporated into the new reissue declaration filed with this response.

## **II. AMENDMENT**

The claims are amended above according to the agreement with the Examiner as reached in the interview on June 2, 2005, and to address all of the rejections and objections raised in the Office Action dated May 9, 2005.

Additionally, claims 27, 31, 40, 73 and 78 are amended to correct the spelling of the word "eucalyptus," and claims 107 and 113 are amended to parallel the language of the claims originally issued in U.S. Patent No. 5,633,435 (with the exception of the reference to SEQ ID NO. 70 instead of the sequence domains). Finally, the claims are amended and new claims are added in order to have a separate set of claims for (i) the sequence domains and SEQ ID NOS. 41, 42, 43 and 44, (ii) SEQ ID NOS. 2, 3, 4, 5, and 6 and 7, and (iii) SEQ ID NO. 70, and for each of those sets are claimed a recombinant, double-stranded DNA molecule, a method of producing genetically transformed plants which are tolerant toward glyphosate herbicide, a method for selectively controlling weeds in a field containing a crop having planted crop seeds or plants, a plant cell, a plant and a seed.

## **III. REJECTION OF REISSUE OATH AND CLAIMS**

The reissue declaration filed July 18, 2003, is rejected under 35 U.S.C. § 151 because the statement of error is allegedly not specific and does not point out how the proposed error is corrected. The rejection further states that the reissue declaration lacks a statement reflecting the amended claims filed in the preliminary amendments. Claims 1-131 are also rejected as being based upon a defective reissue declaration under 35 U.S.C. § 251.

In response, applicants enclose a new reissue declaration that further explains the error and how it is corrected. The new reissue declaration also refers to all amendments made to the claims after the filing of this reissue application on July 18, 2003.

Accordingly, the enclosed reissue declaration should be entered and the rejections under 35 U.S.C. §§ 151 and 251 should be withdrawn.

#### **IV. CONSIDERATION OF REFERENCES C41, C43, C44 AND C48**

References C41, C43, C44 and C48, which were cited in applicants' information disclosure statement filed April 11, 2005, have not been considered because they are in the Japanese language. The Examiner has, however, acknowledged the summary interpretation of the references in the information disclosure statement.

In order to have those references considered by the Examiner, applicants submit the enclosed certified English language translations (C109-C112).

Accordingly, translated references C41, C43, C44 and C48 should be considered and published on the face of the reissue patent.

#### **V. OBJECTION TO INFORMALITY IN DISCLOSURE**

The disclosure is objected to because of the alleged informality of SEQ ID NO:70 not being underlined in the amendment to the specification to indicate insertion of new text.

Accordingly, the amendment adding SEQ ID NO:70 is resubmitted above in underlined form, and this objection should be withdrawn.

**VI. OBJECTION TO AMENDED SEQUENCE LISTING UNDER 35 U.S.C. § 251**

The amended sequence listing is objected to under 35 U.S.C. § 251 as allegedly being based upon new matter (the amino acid sequence disclosed in SEQ ID NO:70) that is not supported by the prior patent. Applicants respectfully traverse this objection.

The amino acid sequence of SEQ ID NO: 70 is fully supported by the specification of U.S. Patent No. 5,633,435. SEQ ID NO:70 is described by SEQ ID NO:3 and the text at col. 5, ll. 50-53 (which identifies SEQ ID NO:3 as the CP4 amino acid sequence); and col. 28, ll. 54-55 (which states that the second codon of the DNA sequence encoding the CP4 amino acid sequence was converted to a codon for leucine). In other words, SEQ ID NO:70 is simply SEQ ID NO:3 with the described change to leucine at position 2.

As agreed by the Examiner in the interview conducted June 2, 2005, this disclosure supports SEQ ID NO:70 under 35 U.S.C. § 112 and is not new matter in this reissue application. Accordingly, the objection to the sequence listing under 35 U.S.C. § 251 should be withdrawn.

**VII. CLAIM FOR PRIORITY**

The Examiner notes that the claim for priority is confusing because this application is being examined as a reissue application and copendency between the current application and the prior application are required. Applicants clarify that this is a reissue application and, as such, the reissue patent will have the same term as the underlying U.S. Patent No. 5,633,435. Accordingly, the reissue patent should receive the benefit of prior application Serial Nos. 08/306,063, filed September 13, 1994; Serial No. 07/749,611, filed August 28, 1991; and Serial No. 07/576,537, filed August 31, 1990.

### **VIII. OBJECTION TO CLAIM INFORMALITIES AND DEPENDENCIES**

Claims 2, 3, 5-14, 16-23, 24-31, 33-85 and 113 are objected to for a number of alleged informalities. Each of these claims is amended above according to the Examiner's suggestion.

Claims 6, 8, 16, 19, 33, 36 and 88-105 are objected to as allegedly being of improper dependent form for failing to further limit the subject matter of a previous claim. The claims are amended to be of proper dependent form consistent with the claims from which they depend. In particular, those claims are amended to replace the language "provided that when  $X_1$  is D,  $X_2$  is T,  $X_3$  is S, and  $X_4$  is V, then  $X_5$  is not P," with "provided that when  $X_1$  is D,  $X_2$  is T,  $X_3$  is S, and  $X_4$  is V, then  $X_5$  is Q."

Accordingly, these objections should be withdrawn.

### **IX. REJECTION OF CLAIMS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH (INDEFINITENESS)**

Claims 7, 9, 10, 14, 17, 20, 34, 79-85, 87-90 and 93 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for allegedly failing to particular point out and distinctly claim the subject matter which applicants regard as their invention.

Claims 7, 9, 17, 20, 34, 88, 89, 90 and 93 are rejected as allegedly indefinite because the list of SEQ ID NOs further limits "an EPSPS enzyme" and not the "DNA sequence." The claims from this set that have not been cancelled are amended above to clarify that the SEQ ID NOs recited in these claims are DNA sequences (EPSPS encoding sequences), and not amino acid sequences.

Claim 10 is rejected as allegedly indefinite because "the limitation 'the EPSPS sequence' lacks proper antecedent basis in the claim(s) upon which it depends." Claim 10 is amended

above to refer to “the EPSPS enzyme,” which has proper antecedent basis in the claim from which it now depends.

Claims 79-85 and 87 are rejected as being indefinite because it is allegedly unclear whether the claimed seed of a glyphosate-tolerant plant comprises the transgene or if a non-transgenic seed is encompassed. Claims 79-85 and 87 are amended above to clarify that the claimed seed comprises the transgene.

Therefore, the rejections under 35 U.S.C. § 112, second paragraph, should be withdrawn.

**X. REJECTION OF CLAIMS UNDER 35 U.S.C. § 112,  
SECOND PARAGRAPH (WRITTEN DESCRIPTION)**

Claims 86 and 87 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Claims 86 and 87 are cancelled by the above amendment and, therefore, this rejection is moot.

**XI. REJECTION OF CLAIMS UNDER 35 U.S.C. § 251 AND 112,  
FIRST PARAGRAPH (NEW MATTER)**

Claims 4, 5, 15, 18, 32, 35, 41-52 and 106-131 are rejected under 35 U.S.C. §§ 251 and 112, first paragraph as being based upon new matter added to the patent for which reissue is sought.

Claims 4, 5, 15, 18, 32, 35 and 41-52 are rejected based on the language “provided that when X<sub>1</sub> is D, X<sub>2</sub> is T, X<sub>3</sub> is S, and X<sub>4</sub> is V, then X<sub>5</sub> is not P.” This language has been deleted from those claims and, therefore, this rejection is moot. The claims now recite the language “provided that when X<sub>1</sub> is D, X<sub>2</sub> is T, X<sub>3</sub> is S, and X<sub>4</sub> is V, then X<sub>5</sub> is A, R, N, D, C, Q, E, G, H, I, L, K, M, F, S, T, W, Y or V,” which the Examiner agreed in the interview of June 2, 2005, was supported by the specification and, accordingly, was not new matter.

Claims 106-131 are rejected as encompassing new matter based on the references to SEQ ID NO. 70. Applicants respectfully traverse this rejection. As explained in section V above, the amino acid sequence of SEQ ID NO: 70 is fully supported by the specification of U.S. Patent No. 5,633,435. SEQ ID NO:70 is described by SEQ ID NO:3 and the text at col. 5, ll. 50-53 (which identifies SEQ ID NO:3 as the CP4 amino acid sequence); and col. 28, ll. 54-55 (which states that the second codon of the DNA sequence encoding the CP4 amino acid sequence was converted to a codon for leucine). In other words, SEQ ID NO:70 is simply SEQ ID NO:3 with the described change to leucine at position 2.

As agreed by the Examiner in the interview conducted June 2, 2005, this disclosure supports SEQ ID NO:70 under 35 U.S.C. § 112 and is not new matter in this reissue application.

Therefore, these rejections under 35 U.S.C. §§ 251 and 112, first paragraph, should be withdrawn.

### **CONCLUSION**


In view of the foregoing, applicants believe that the claims in this application are in condition for allowance. If, in the opinion of the Examiner, a telephonic interview would expedite the prosecution of the subject application, the Examiner is invited to contact the undersigned attorney at the telephone number listed below.

If any fees are required for any reason related to this application, the Commissioner is authorized to deduct said fees from Deposit Account No. 01-2508/11899.0175.REUS07/WAA

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Respectfully submitted,

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